



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/197,844	11/23/1998	GAD JANAY	030	1758

7590 12/03/2002

KAPLAN & GILMAN  
COUNSELORS AT NORTH  
900 ROUTE 9 NORTH  
WOODBIDGE, NJ 07095

EXAMINER

PAULA, CESAR B

ART UNIT	PAPER NUMBER
----------	--------------

2178

DATE MAILED: 12/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Applicati n No.

09/197,844

Applicant(s)

JANAY, GAD

Examin r

CESAR B PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. This action is responsive to the RCE filed on 9/9/02.

**This action is made Non-Final.**

2. In the amendment, claims 15-18 have been added. Claims 1-18 are pending in the case.

Claims 5, 10-11, and 15 are independent claims.

3. The rejections of claims 1-2 under 35 U.S.C. 103(a) as being unpatentable over Yoda (Pat.# 5,890,173, 3/30/99, filed 11/20/96) have been withdrawn as necessitated by the amendment.

4. The rejections of claims 3-4 under 35 U.S.C. 103(a) as being unpatentable over Yoda in view of Ikenoue et al, hereinafter Ikenoue (Pat. # 5,987,127, 11/16/99, filed on 7/15/97) have been withdrawn as necessitated by the amendment.

5. The rejections of claims 5-11, and 13-14 under 35 U.S.C. 103(a) as being unpatentable over of Warmus et al, hereinafter Warmus (Pat.# 6,327,599, 12/4/01, filed 6/7/95) have been withdrawn as necessitated by the amendment.

6. The rejections of claim 12 under 35 U.S.C. 103(a) as being unpatentable over of Warmus et al, hereinafter Warmus, in view of Ikenoue has been withdrawn as necessitated by the amendment.

### *Drawings*

7. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

***Specification***

8. The substitute specification filed in the amendment has been entered in the file.

***Claim Rejections - 35 USC § 112***

9. The rejection of claim 2 for having insufficient antecedent basis, has been withdrawn as necessitated by the amendment.

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-3, 5-11, and 13-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corona et al, hereinafter Corona (Pat.# 5,316,279, 5/31/94), in view of Barnes, "10 Minute Guide To Windows 3.1", SAMS, 1992, p.119-123, and further in view of Warmus et al, hereinafter Warmus (Pat.# 6,327,599, 12/4/01, filed 6/7/95).

Regarding independent claim 1, Corona discloses automatically intercepting a print job sent to a printer and adding additional/different cover and trailer sheets with the user's/job related information. New information is added onto the template to produce several documents containing different information (c.1, L.6-67, c.4, L.1-67, c.6, L. 1-c.8,L.67). Corona fails to explicitly disclose *a print spool*. Barnes teaches a print manager spooler for feeding a print job

Art Unit: 2178

to a designated printer (p.119-120). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Corona, and Barnes, because Barnes teaches above a print manager for holding print jobs not printed by the printer.

Furthermore, Corona fails to explicitly disclose *a database to determine other information relevant to such data*. Warmus teaches the printing of additional information related to a print job. The additional information is retrieved from a database (c.6,L.1-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Corona, Barnes, and Warmus, because Warmus teaches above the printing of customized additional without having additional user input.

Claims 2-3 is directed towards a tool for implementing the tool of claim 1, and therefore are similarly rejected.

Claims 5-6 is directed towards a tool for implementing the tool of claim 1, and therefore are similarly rejected.

Regarding claim 7, which depends on claim 5, Warmus discloses the intercepting of a document template—*original format*— to be printed and using this information for the retrieval of variable data from a database. New information is added onto the template to produce several documents containing different information in a double-side printing format (col.3, line 7-col.4, line 21, col.6, lines 1-67, and col.7, line1-col.8, lines 1-67).

Claims 8-11, and 13-14 are directed towards a formatting tool for implementing the tool of claims 6, 6, and (5 & 9), 5, 5, and 5, and therefore are similarly rejected.

Art Unit: 2178

12. Claims 3-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corona, in view of Barnes, and further in view of Ikenoue et al, hereinafter Ikenoue (Pat. # 5,987,127, 11/16/99, filed on 7/15/97).

Regarding claim 4, which depends on claim 3, Corona discloses automatically intercepting a print job sent to a printer and adding additional/different cover and trailer sheets with the user's/job related information (c.1, L.6-67, c.4, L.1-67, c.7, L. 1-67). Corona fails to explicitly disclose *whether or not information is confidential*. Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Corona, Barnes, and Warmus, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Regarding claim 12, which depends on claim 5, Corona discloses automatically intercepting a print job sent to a printer and adding additional/different cover and trailer sheets with the user's/job related information (c.1, L.6-67, c.4, L.1-67, c.7, L. 1-67). Corona fails to explicitly disclose fails to explicitly disclose *second portion is a confidential portion*. Ikenoue teaches the embedding of additional data about a document, such as whether or not a document is secret, onto hard copies of a document for security and copyright purposes (col.2, lines 24-67, and col.5, lines 1-col.6, line 67). However, it would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Corona, Barnes, and Warmus, and Ikenoue, because Ikenoue teaches above an effective document copy management tool.

Art Unit: 2178

13. Claims 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Corona, and further in view of Warmus.

Regarding independent claim 15, Corona discloses automatically intercepting a print job sent to a printer and adding additional cover and trailer sheets with the user's/job related information. New information is added onto the template to produce several documents containing different information (c.1, L.6-67, c.4, L.1-67, c.6, L. 1-c.8,L.67). Corona fails to explicitly disclose *an identification segment, parsing identification segment*. It would have been obvious to one of ordinary skill in the art at the time of the invention to have included the identification segment, because Corona teaches above retrieving, and printing additional information based on a user's/job name.

Furthermore, Corona fails to explicitly disclose *accessing, and acquiring from the database data having first and second defined portions*. Warmus teaches the printing of additional information related to print jobs related to various users. The additional information is retrieved from a database (c.6,L.1-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Corona, Barnes, and Warmus, because Warmus teaches above the printing of customized additional without having additional user input.

Claims 16-18 are directed towards a method for implementing the tool of claim 15, and therefore are similarly rejected.

***Response to Arguments***

14. Applicant's arguments with respect to claims 1-14 have been considered but are moot in view of the new ground(s) of rejection. The Applicant submit that Yoda fails to teach the use of a specified portion of the intercepted data as a key to access a database to determine other information (p.6,L.12-15). The Applicants are referred to the rejection of these newly added claim limitations as outlined above.

The Applicant further submits that Ikenoue fails to teach the use of a specified portion of the intercepted data as a key to access a database to determine other information (p.7,L.1-8). The Applicants are referred to the rejection of these newly added claim limitations as outlined above.

Furthermore, the Applicant submit that none of the references teach or suggest the customization of individual copies of documents (p.8, lines 4-10). The Applicants are referred to the rejection of these newly added claims as outlined above.

***Conclusion***

I. The prior art-made of record and not relied upon is considered pertinent to applicant's disclosure. Kadowaki (Pat. # 6,313,921), Meetze (Pat. # 5,980,676) and Costello (Pat. # 5,547,178).

II. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The



Art Unit: 2178

examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry, except formal After Final communications)


Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label "PROPOSED" or "DRAFT" ).

**Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).**

CBP

11/29/02

  
STEPHEN HONG  
PRIMARY EXAMINER